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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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09/17/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/550,132	Applicant(s) NONOMURA ET AL.	
	Examiner TAMRA L. DICUS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-19 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/21/05, 11/21/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6-14, drawn to a newsprint paper.

Group II, claim(s) 15-19 drawn to a method of manufacturing a newsprint paper.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature does not provide a contribution over the prior art because the special technical feature namely the paper including a filler as claimed is disclosed in Klyosov et al. (US 5,919,424).

During a telephone conversation with Dan Altman on September 3, 2008 a provisional election was made with traverse to prosecute the invention of I, claims 6-14. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 15-19 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process

claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Klyosov et al. (US 5,919,424).

Klyosov teaches a papermaking sludge wherein it is well known to have typically included filler from 20% to 75% of dry sludge content, resulting ash, where precipitated calcium carbonate is selected to improve the appearance of paper (falls in Applicant's recited ranges). See 1:15-35, 2:35-60, 3:7-68, Examples (showing in Example I of 23% calcium carbonate, falling within 15-

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40% filler range as claimed) and Tables. Klyosov teaches a paper, which is seen as functioning as a newsprint paper for offset printing since the same material and structure is taught, see MPEP 2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. Consequently, “preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.” In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). How the calcium carbonate is produced (i.e. by a chemical method) carries little weight because it is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. In *re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. In *re Brown*, 459 F. 2d 531. Both Applicant’s and prior art reference’s product are the same.

Claims 6-8 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klyosov et al. (US 5,919,424) in view of Munchow (US 6,214,166).

Klyosov teaches paper with calcium carbonate as set forth above.

Klyosov doesn't teach the grain size or zeta potential properties as claimed (9-12).

However, Munchow teaches paper having fillers where the grain size plays an important role in effecting the physical properties of the paper, and in particular the porosity (1:20-50).

Thus, it would have been obvious to one having ordinary skill in the art to have modified the paper of Klyosov to vary the grain size to effect porosity as taught by Munchow, further unmentioned properties that naturally flow therefrom are expected and thus inherent. See above.

Applicant's attention is directed to the following: It is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229.

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Since the references teach all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims.

General Electric v. Jewe Incandescent Lamp Co., 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See also MPEP § 2144.05 II (B).

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klyosov et al. (US 5,919,424) in view of Hirabayashi et al. (US 6,458,413).

Klyosov teaches the claimed invention above.

Klyosov doesn't teach a clear coat or deinked pulp (claims 13—14), while generally teaching dry paper sludge.

Hirabayashi teaches dry paper sludge such as deinked pulp used as paper pulp in web-offset printing for coated paper (12:15-35) wherein the coat is from known polyvinyl alcohol (PVA), the same ingredient Applicant admits yields the clear coat described on page 4, last paragraph of the instant specification, which heightens the inner bond strength and adds blister resistance to the surface of paper for web-offset printing (11:35-68). See also 3:35-68, 4:15-50.

Thus it would have been obvious to one having ordinary skill in the art to modify the paper of Klyosov to include a clear coat and deinked pulp because Hirabayashi teaches the additions help to heighten the inner bond strength and adds blister resistance to the surface of paper for web-offset printing as cited above.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klyosov et al. (US 5,919,424) in view of Hirabayashi et al. (US 6,458,413) and Maruyama et al. (US 5,527,852).

Klyosov teaches the claimed invention above.

Klyosov doesn't teach a clear coat or deinked pulp (claims 13—14), while generally teaching dry paper sludge.

Hirabayashi teaches dry paper sludge specifically including deinked pulp used as paper pulp in web-offset printing for coated paper (12:15-35) wherein the coat is comprised of known polyvinyl alcohol (PVA), which heightens the

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inner bond strength and adds blister resistance to the surface of paper for web-offset printing (11:35-68). See also 3:35-68, 4:15-50.

Hirabayashi doesn't teach the PVA is clear.

Maruyama teaches PVA is a clear coating agent known to improve the surface characteristics of paper, such as smoothness, luster, and barrier properties. See 1:10-20, 2:50-68, Example 1.

Thus it would have been obvious to one having ordinary skill in the art to modify the paper of Klyosov to include a clear coat and deinked pulp because Hirabayashi teaches the additions help to heighten the inner bond strength and adds blister resistance to the surface of paper for web-offset printing as cited above and Maruyama teaches PVA is a clear coat known to improve surface characteristics of paper, such as smoothness, luster, and barrier properties as cited above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

September 3, 2008